



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/648,314	08/25/2000	Andrej Gregov	SEAZN.238A	6403
79502	7590	07/15/2010		
Knobbe, Martens, Olson & Bear, LLP 2040 Main Street Fourteenth Floor Irvine, CA 92614			EXAMINER LEROUX, ETIENNE PIERRE	
			ART UNIT	PAPER NUMBER
			2161	
			NOTIFICATION DATE	DELIVERY MODE
			07/15/2010	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com  
efiling@kmob.com

<b>Office Action Summary</b>	<b>Application No.</b> 09/648,314	<b>Applicant(s)</b> GREGOV ET AL.	
	<b>Examiner</b> Etienne P. LeRoux	<b>Art Unit</b> 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15, 16, 27-35 and 40-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15, 16, 27-35 and 40-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

*Claim Status*

Claims 15-16, 27-35 and 40-51 are rejected

The Board of Patent Appeals and Interferences provided Decision on Appeal on April 20, 2010. Included in the Decision on Appeal was New Ground of Rejection under 35 U.S.C. § 112, first paragraph (written description). New grounds of rejection of claims 15-16, 27-35 and 40-51 was entered under 35 U.S.C. § 112, first paragraph, because the claim limitation “the generated list does not contain the selected seed items” recited in independent claims has not met the written description requirement under 35 U.S.C. § 112, first paragraph.

Applicant Argues:

Applicant quotes the following section from the specification.

In Figure 6, this list of seed items only includes one seed item, item 691 corresponding to item 550 shown in Figure 5. Figure 6 also shows a list of recommended items 610, 620, 630, 640 and 650. These recommended items are based upon using seed item 691 alone as a seed for the recommendation engine.

Furthermore, applicant enters the following argument.

In accordance with the embodiment illustrated in Figure 6, a single seed item 691 is utilized to generate a set of recommendations 610, 620, 630, 640 and 650. Moreover, and as illustrated in

Art Unit: 2161

Figure 6 (below), none of the recommended items 610, 620, 630, 640 and 650 correspond to the seed item, item 691. Therefore, Figure 6 and its corresponding description clearly convey applicant's possession of the recited limitation "wherein the generated list does not contain the selected seed items."

Examiner Responds:

Examiner is not persuaded. Figure 5 shows a generated list of recommended items for digital photography. The generated list includes The Art of Digital Photography, by Tom Ang, item 550. Figure 6, shows a seed item 691 which is The Art of Digital Photography, by Tom Ang. Clearly the written description contradicts the claim limitation "wherein the generated list does not include the selected seed item" because the generated list of recommended items of Figure 5 includes the seed item 691 of Figure 6.

Furthermore, the written description has the following instances where a list of recommended items includes a seed item in contradiction (emphasis added) to the claim limitation "wherein the generated list does not contain the selected seed items."

The Complete Idiot's Guide to Digital Photography, by Steve Greenberg, Paperback

- (1) Seed Item 411 per Figure 4.
- (2) Recommended item 510, Figure 5
- (3) Recommended item 650, Figure 6

Art Unit: 2161

Digital Camera Solutions, Gregory Georges, Paperback

- (1) Seed Item 412, Figure 4
- (2) Recommended Item 540, Figure 5

Real World Digital Photography Industrial Strength Techniques, by Duke McClelland, Katrin Eismann, Paperback

- (1) Seed Item 413, Figure 4
- (2) Recommended item 520, Figure 5
- (3) Recommended item 620, Figure 6

The New Media Guide to Creative Photography, Image Capture and Printing in the Digital Age, by John Carucci.

- (1) Recommended item 630, Figure 6
- (2) Seed item 631, Figure 6

Clearly, the written description included in the specification contradicts (emphasis added) “generating a list of recommended items each based on the selected seed items, wherein the generated list does not contain the selected seed items” because five books are simultaneously a seed item and a recommended item.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2161

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne P. LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached on Monday through Friday, 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Apu Mofiz can be reached on (571) 272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2161

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Etienne P LeRoux/  
Primary Examiner, Art Unit 2161

7/12/2010